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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHIL WYATT

Appeal 2008-1461
Application 09/544,509
Technology Center 3600

Decided: June 24, 2008

Before LINDA E. HORNER, ANTON W. FETTING, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

Phil Wyatt (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We reverse.

The Appellant's Invention

The Appellant's invention is directed to a method and a system for matching medical condition information to a medical resource. (Spec. 1:7-9.) The system includes a plurality of remote servers 10, 12 which respectively contain websites 14, 16. (Spec. 7:32-33.) Each website is connected to databases 18, 20 and each database contains information related to a plurality of medical conditions and medical resources which could treat the medical conditions. (Spec. 7:33 - 8:4.) The remote servers may access either of the databases and the servers may be incorporated into a computer network 22. (Spec. 8:4-8.) Users using remote computers 24, 26 connected to the network 22 will access websites 14, 16 on the remote servers 10, 12 to access the information within the databases. (Spec. 9:4-12.) A user will enter a particular medical procedure or condition. (Spec. 9:24-27.) The medical procedures or conditions are stored in the medical databases (Spec. 10:18-20.) After a user has selected a particular medical condition or procedure, the user can search the databases 18, 20. (Spec. 11:17-20.) The databases 18, 20 also contain the information related to medical resources. (Spec. 11:20-21.) A particular medical resource that matches the medical condition or procedure designated by the user may be output to the remote computer 24, 26 that the user is using. (Spec. 11:29-34.) In addition, medical resources may be matched to any personal information provided by the user. (Spec. 12:16-19.)

Claim 1, reproduced below, is representative of the subject matter on appeal.

> 1. A method for matching medical condition information with a medical resource, the method comprising the steps of:
>
> providing a computer network having a plurality of remote computers and at least one remote server wherein the remote server hosts a website;
>
> accessing the website via an individual remote computer on the computer network;
>
> inputting a query into the website wherein the query relates to a first medical condition;
>
> providing a database on the remote server wherein the database stores first information relating to a plurality of medical conditions and second information relating to a plurality of medical resources wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which[1] at least one of the plurality of medical conditions;
>
> searching the first information and the second information in the database based on the query input into the website wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources in the first information wherein a medical resource from the plurality of medical resources in the second information is matched to

[1]We note that the Examiner has interpreted this phrase to include the term "treat." (Ans. 7.) Accordingly, we will likewise interpret the phrase to read "which [treat] at least one of the plurality of medical conditions." Further prosecution before the Examiner should correct this informality.

> the medical condition of the query wherein the medical condition of the query is treatable by the medical resource; and
>
> displaying third information via the individual remote computer wherein the third information relates to the second medical condition and further wherein the third information relates to the medical resource which matches the medical condition of the query.

THE REJECTIONS

The Examiner has rejected claims 1-20 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The Examiner has rejected claim 1 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention.

The Examiner has rejected claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over the Business Wire article "Specialty care Network Announces Internet Strategy; New HealthGrades.com Site to Offer Provider and Health Plan Rating Information" June 30, 1999, Business Wire, p1519 (HealthGrades) and Appellant's Admission of Prior Art (AAPA).

FINDINGS OF FACT

We find that the following enumerated findings of fact are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Appellant's Specification discloses that it is known in the prior art to provide access to databases that contain medical information. (Spec. 2:3-13.)
2. HealthGrades describes the development of a consumer-oriented site that will provide information on a variety of healthcare providers, (HealthGrades, para. 1).
3. HealthGrades describes that it plans to be the leading Web-based site for the distribution of free health care provider and health plan rating information, (HealthGrades, para. 2).
4. HealthGrades describes that people are interested in knowing where to go for the best medical care and that HealthGrades plans to provide that information, (HealthGrades, para. 3).
5. HealthGrades describes providing ratings on medical facilities, (HealthGrades, para 4).
6. HealthGrades describes planning on expanding its existing website to be a portal for consumers to locate information on medical facilities, physicians, and health plans, (HealthGrades, para. 5).

PRINCIPLES OF LAW

All that is necessary to satisfy the description requirement for 35 U.S.C. § 112, first paragraph, is to show that one is "in possession" of the invention. *Lockwood* accurately states the test. *See Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

The test for 35 U.S.C. § 112, second paragraph, compliance is whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the application disclosure as they would be interpreted by one of ordinary skill in the art. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these

questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *see also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). All the claim limitations must be taught or suggested by the prior art to establish a prima facie case of obviousness. *In re Royka*, 490 F.2d 981 (CCPA 1974).

ANALYSIS

35 U.S.C. § 112, first paragraph, rejection

The Examiner's position is the following claim limitations are not supported by the original disclosure:

> • "wherein the medical condition of the query is matched to a second medical condition" [as recited] in claim 1 at lines 21-22;
> • "wherein the third information relates to the second medical condition"[as recited in claim 1] at lines 30-31; [and]
> • "means for disclosing second information wherein the second information relates to one of the plurality of medical conditions of the query" [as recited] in claim 15 at lines 24-26.

(Ans. 5.)

The Appellant states on pages 7 and 8 of the Appeal Brief:

> Moreover, the specification discloses that "[t]he search of the database 66 may match the medical resources with the particular medical conditions and/or medical procedures chosen by the individual." Page 11, lines 25-28. Therefore, Appellant submits

> that the specification discloses that the medical condition of the query is matched to a second medical condition or that the third information relates to the second medical condition, respectively, as required by Claim 1.

(App. Br. 7.)

We agree with the Appellant. As we understand the invention, see *supra*, the Appellant was in possession of the invention as now claimed. As identified by the Appellant in the Appeal Brief, the Specification at the time of filing did disclose the search of the database 66 to match medical resources to medical conditions.

Accordingly, we will not sustain the Examiner's rejection of claims 1-20 under 35 U.S.C. § 112, first paragraph.

35 U.S.C. § 112, second paragraph, rejection

The Examiner's position is:

> Claim 1 recites "matched to a second medical condition from the plurality of medical resources in the first information" on lines 22-23. However[,] the "first information" as defined in claim 1 relates to "a plurality of medical conditions," not a plurality of medical "resources."

(Ans. 6.)

In response, the Appellant states:

> Claim 1 requires that the first information relates to a plurality of medical conditions and that the second information relat[es] to a plurality of medical resources. In other words, a second medical condition in the first information is matched from the plurality of medical resources.

(App. Br. 9.)

Again, we agree with the Appellant. From the Specification, the patient enters a medical condition and that is the first medical condition. This first medical condition is looked up from the plurality of medical conditions in the database and this plurality of medical conditions in the database is the first information relating to the plurality of medical conditions. Then, the system matches the condition to resources (the second information) that are also within the database. Accordingly, this is the searching the first and second information to find a match based on what the patient entered as the query, the first medical condition. In other words, the system matches the condition to a resource that can handle the condition.

Accordingly, we will not sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 112, second paragraph.

35 U.S.C. § 103(a) rejections

The Examiner has interpreted the content of paragraph 5 in HealthGrades as describing the storing of first and second information, searching such information to obtain a match of a medical condition to a medical resource, and displaying the information that relates to the match of the medical condition to the medical resource as has been claimed. (Ans. 7-9.) The Appellant responded that the Examiner's interpretation of Healthgrades is incorrect and has not provided specific teachings in any reference of the claimed limitations. (App. Br. 17.) Moreover, the

Appellant contends that what the Examiner has identified as AAPA is no more than a disclosure of the deficiencies and problems of the prior art. (*Id.*)

We agree with the Appellant. As we understand the Appellant's disclosure of prior art, it is known in the prior art to provide access to databases that contain medical information. (Fact 1.) As we understand the scope and content of HealthGrades, HealthGrades describes the development of a consumer-oriented site that will provide information on a variety of healthcare providers, (Fact 2). HealthGrades describes that it plans to be the leading Web-based site for the distribution of free health care provider and health plan rating information, (Fact 3). HealthGrades describes that people are interested in knowing where to go for the best medical care and that HealthGrades plans to provide that information, (Fact 4). HealthGrades describes providing ratings on medical facilities, (Fact 5). HealthGrades describes planning on expanding its existing website to be a portal for consumers to locate information on medical facilities, physicians, and health plans, (Fact 6). HealthGrades does not describe storing first information relating to a plurality diseases and disorders and second information relating to a plurality of medical resources which treat at least one of the stored plurality of diseases and disorders, searching such information to obtain a match of a disease or disorder to a medical resource, and displaying such information relating to a match. Accordingly, the Appellant is correct to say that the Examiner's interpretation of the scope and content of Healthgrades is incorrect and that the Examiner has not provided specific teachings in any reference of the claimed limitations.

Because the Appellant has identified an error in the Examiner's interpretation as to the scope and content of Healthgrades and AAPA and that the Examiner has failed to identify specific teachings in Healthgrades or the AAPA of the claimed limitations, we determine that the Examiner has failed to set forth a prima facie case of obviousness, and we will not sustain the rejection of claims 1-20 as unpatentable over Healthgrades and the AAPA.

CONCLUSIONS

We conclude that the Appellant has shown the Examiner erred in rejecting:

Claims 1-20 under 35 U.S.C. 112, first paragraph; as containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention with respect to the limitations of: "wherein the medical condition of the query is matched to a second medical condition" as recited in claim 1 at lines 21-22; "wherein the third information relates to the second medical condition" as recited in claim 1 at lines 30-31; and "means for disclosing second information wherein the second information relates to one of the plurality of medical conditions of the query" as recited in claim 15 at lines 24-26.

Claim 1 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention with respect to the claim limitation of "the medical condition of the query is matched to a second medical condition from the plurality of medical resources in the first information" in claim 1 on lines 22-23.

Claims 1-20 under 35 U.S.C. § 103(a) as unpatentable over the scope and content of Healthgrades and the AAPA.

DECISION

The decision of the Examiner to reject claims 1-20 is reversed.

REVERSED

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